

REMARKS

This responds to the Office Action mailed on July 5, 2006.

Claim 12 is amended. Claims 13-16 are canceled. No claims are added by way of this response. As a result, claims 8-12, 20, and 21 are now pending in this application.

For the convenience of the Examiner, Applicants' remarks concerning the claims will be presented in the same order in which the Examiner presented them in the Office Action.

Interview Summary

Applicants thank Examiner Ricardo L. Osorio for the courtesy of a telephone interview on March 26, 2006 with staff for Applicants' representative, Anne Richards. The fact that the Office Action mailed on March 3, 2006 did not include reference to all of the pending claims was discussed. The Examiner agreed to issue a new Office Action to consider all of the pending claims.

Supplemental Information Disclosure Statement

Applicants respectfully request that a copy of the 1449 Form, listing all documents that were submitted with the Supplemental Information Disclosure Statement filed on February 17, 2006, marked as being considered and initialed by the Examiner, be returned with the next official communication.

Affirmation of Election

Restriction to one of the following claims was required under 35 U.S.C. 121:

- I. Claims 8-16, 20 and 21, drawn to a stylus comprising a microphone, classified in class 345, subclass 179.
- II. Claims 23-27, voice communication between a PDA and a PC, classified in class 704, subclass 200.

As provisionally elected by Applicants' representative, Walter W. Nielsen, on April 11, 2006, Applicants elect to prosecute the invention of Group I, claims 8-16, 20 and 21.

The claims of the non-elected invention, claims 23-27, are hereby canceled. Applicants reserve the right to later file continuations or divisions having claims directed to the non-elected inventions.

Amendments to Claim 12

Claim 12 has been amended by adding the limitations that the PDA stores the electronic voice signals when the PDA is located geographically away from the PC such that communication between the PDA and the PC is not possible; and the PDA transmits the electronic voice signals to the PC when the PDA is located geographically such that communication between the PDA and PC is possible.

Applicants assert that adequate support for this amendment may be found in Applicants' original specification, beginning on page 5, line 28 through page 6, line 4. Applicants' undersigned attorney points out that these limitations were previously presented in claim 17, which was canceled in a previous response in response to a rejection of under 35 U.S.C. 112.

No new matter has been introduced.

**Rejection of Claims 8-14, 16 and 20
under 35 U.S.C. §103(a) as Unpatentable
over Horie in view of Stevens**

Claims 8-14, 16, and 20 were rejected under 35 U.S.C. §103(a) as being unpatentable over Kiyoshi Horie (JP 06131108 A) in view of Stevens III (U.S. 5,769,643).

Claims 13-16 have been canceled.

The Examiner has the burden under 35 U.S.C. §103 to establish a *prima facie* case of obviousness. *In re Fine*, 837 F.2d 1071, 1074, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988). In combining prior art references to construct a *prima facie* case, the Examiner must show some objective teaching in the prior art or some knowledge generally available to one of ordinary skill in the art that would lead an individual to combine the relevant teaching of the references. *Id.*

The MPEP §2142 contains explicit directions to the Examiner in consonance with the *In re Fine* holding:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. (Citing *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991)).

Regarding independent claim 8, a *prima facie* case of obviousness is not established, because the references, even when combined as the Examiner suggests, fail to disclose all of the recited elements. The combination of Horie and Stevens fails to disclose a PDA to display translated voice data, and further wherein the PDA receives transmitted voice data from a personal computer and receives electronic voice signals from a stylus. In his rejection, the Examiner is apparently choosing to read the limitation "personal computer" on Horie's tablet computer. Having done so, the Examiner cannot then read Applicants' limitation "PDA" on the tablet computer. Stevens discloses communication of data between a notebook computer and a PC. However, Stevens fails to disclose a PDA or handheld computer to display translated voice data, and to receive transmitted voice data from a personal computer and to receive electronic voice signals from a stylus.

For the above reason, independent claim 8 should be allowable over the Examiner's suggested combination of Horie and Stevens.

Regarding independent claim 12, the combination of Horie and Stevens fails to disclose a PDA receiving electronic voice signals transmitted from a hand-held stylus; the PDA storing the electronic voice signals when the PDA is located geographically away from a PC such that communication between the PDA and the PC is not possible; the PDA transmitting the electronic voice signals to the PC when the PDA is located geographically such that communication between the PDA and PC is possible; the PC translating the electronic voice signals into translated voice data; the PC transmitting the translated voice data to the PDA; and the PDA storing the translated voice data. Thus, claim 12 should be patentable over Horie and Stevens.

Dependent claims 9-11, 20, and 21, which depend from independent claim 8, and incorporate all of the limitations therein, are also asserted to be allowable for the reasons presented above.

Rejection of Claim 15
under 35 U.S.C. §103(a) as Unpatentable
over Horie in view of Stevens
and further in view of Wakisaka

Claim 15 was rejected under 35 U.S.C. §103(a) as being unpatentable over Horie and Stevens, and further in view of Wakisaka et al. (U.S. 6,112,174).

Claim 15 has been canceled.

Rejection of Claim 15
under 35 U.S.C. §103(a) as Unpatentable
over Horie in view of Stevens
and further in view of Ohashi

Claim 21 was rejected under 35 U.S.C. §103(a) as being unpatentable over Horie and Stevens, and further in view of Ohashi (U.S. 5,581,783).

Claim 21 is dependent upon claim 8.

As asserted above, claim 8 is patentable over the Examiner's suggested combination of Horie and Stevens. The addition of Ohashi fails to provide the elements missing from the combination of Horie and Stevens, which elements include a PDA to receive translated voice data from a PC, and further to receive electronic voice signals from a stylus.

For the above reasons, claim 8 should be allowable over any combination of Horie, Stevens, and Ohashi. Likewise, dependent claim 21 should also be allowable.

Additional Elements and Limitations

Applicants consider additional elements and limitations of claims 8-12, 20, and 21 to further distinguish over the cited references, and Applicants reserve the right to present arguments to this effect at a later date.

Conclusion

Applicants respectfully submit that claims 8-12, 20, and 21 are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicants' attorney Ann M. McCrackin (located in Minneapolis, Minnesota) at (612) 349-9592 or Applicants' below-signed attorney (located in Phoenix, Arizona) to facilitate prosecution of this application.

Respectfully submitted,

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